

<b>TO: Mail Stop 8</b> <b>Director of the U.S. Patent &amp; Trademark Office</b> <b>P.O. Box 1450</b> <b>Alexandria, VA 22313-1450</b>	<b>REPORT ON THE</b> <b>FILING OR DETERMINATION OF AN</b> <b>ACTION REGARDING A PATENT OR</b> <b>TRADEMARK</b>
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In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been  
 filed in the U.S. District Court Northern District of California on the following ☐ Patents or ☒ Trademarks:

DOCKET NO. CV 11-01365 EMC	DATE FILED 3/22/11	U.S. DISTRICT COURT 450 Golden Gate Avenue, P.O. Box 36060, San Francisco, CA 94102
PLAINTIFF THE AMERICAN AUTOMOBILE ASSO		DEFENDANT AAA TRANSMISSION
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 see Complaint		
2 829,265		
3 2,158,654		
4 3,316,227		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
1			
2			
3			
4			
5			

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT	 <b>03-29-2011</b>
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CLERK Richard W. Wieking	(BY) DEPUTY CLERK Sheila Rash	DATE March 23, 2011
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Copy 1—Upon initiation of action, mail this copy to Commissioner    Copy 3—Upon termination of action, mail this copy to Commissioner  
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner    Copy 4—Case file copy

ORIGINAL  
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2011 MAR 22 P 3:01

RICHARD W. WICKHAM  
CLERK, U.S. DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

E-filing

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9 THE AMERICAN AUTOMOBILE  
10 ASSOCIATION, INC.

11 IN THE UNITED STATES DISTRICT COURT  
12 FOR THE NORTHERN DISTRICT OF CALIFORNIA  
13 OAKLAND DIVISION

EMC

11 THE AMERICAN AUTOMOBILE  
12 ASSOCIATION, INC.,

13 Plaintiff,

14 v.

15 AAA TRANSMISSION, DAVID  
16 RODRIGUEZ, and LILIAN RODRIGUEZ,

17 Defendants.

CV

11

Civil Case No.:

1365

COMPLAINT FOR TRADEMARK  
INFRINGEMENT, DILUTION,  
FALSE DESIGNATION OF  
ORIGIN, CYBERPIRACY, AND  
UNFAIR COMPETITION

18  
19 Plaintiff The American Automobile Association, Inc. ("AAA") brings this  
20 Complaint for injunctive, monetary, and other relief against Defendants AAA Transmission,  
21 David Rodriguez, and Lilian Rodriguez (collectively "Defendants"). AAA alleges as follows:

22 NATURE OF ACTION

23 1. This is an action for trademark infringement, false designation of origin,  
24 and unfair competition in violation of Sections 32 and 43(a) of the Federal Trademark Act (the  
25 "Lanham Act"), 15 U.S.C. §§ 1114, 1125(a), and California common law; for trademark  
26 dilution in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), California state  
27 law, California Business & Professions Code § 14247, and common law; for trademark  
28 cyberpiracy in violation of Section 43(d) of the Lanham Act, 15 U.S.C. § 1125(d); and for

COMPLAINT

1 unfair competition in violation of the California Unfair Competition Law, California Business &  
2 Professions Code § 17200, *et seq.* AAA seeks injunctive relief, monetary damages, restitution,  
3 and all other appropriate relief, including an order enjoining Defendants from using AAA's  
4 trademarks on their website and in their trade name and requiring Defendants to cancel their  
5 registration for or transfer to AAA the domain name AAATRANSHAYWARD.COM.

6           2. This action arises out of Defendants' knowing and willful violation of  
7 AAA's rights in its famous and distinctive AAA trademarks (the "AAA Marks"). Defendants  
8 have used and continue to use the AAA Marks in commerce without authorization and with full  
9 knowledge that they are not authorized to use those Marks. Specifically, Defendants operate an  
10 automobile repair service under the business name AAA Transmission. Moreover, Defendants  
11 have registered the domain name AAATRANSHAYWARD.COM (the "Disputed Domain  
12 Name") and use the domain to host a website that purports to offer automobile transmission  
13 repair services.

14           3. Defendants' unlawful use of the AAA Marks is likely to cause—and may  
15 have already caused—consumers to believe, erroneously, that AAA has endorsed Defendants'  
16 services, jeopardizing the goodwill associated with AAA's Marks, confusing those consumers  
17 seeking the reliable and dependable services of AAA, and unjustly enriching Defendants.

18           4. Defendants' unlawful acts have lessened the capacity of AAA's famous  
19 AAA Marks to identify and distinguish the products and services AAA provides under those  
20 Marks and thus diluted the distinctive quality of the Marks. Furthermore, Defendants' use of  
21 the famous and distinctive AAA Marks has tarnished and harmed the goodwill and reputation of  
22 the AAA Marks.

23           5. In addition, on information and belief, Defendants have profited from the  
24 unauthorized use of the AAA Marks and have made unauthorized commercial use of the AAA  
25 Marks in California and elsewhere to their benefit and to the detriment of AAA and of  
26 consumers, in violation of the laws identified above.

6. The Court has subject matter jurisdiction under 15 U.S.C. §§ 1121 and 1125 and under 28 U.S.C. §§ 1331 and 1338 in that this case arises under the trademark laws of the United States, 15 U.S.C. § 1051, *et seq.* The Court has jurisdiction over the state law claims under 28 U.S.C. §§ 1338(b) and 1367(a).

### INTRADISTRICT ASSIGNMENT

**PARTIES**

11. Defendant Lilian Rodriguez is an individual who can be reached at 727 Industrial Parkway West, Suite P, Hayward, California 94544. Ms. Rodriguez is an owner and operator of the automobile transmission repair business offered under the business name AAA

1 Transmission. Moreover, on information and belief, Ms. Rodriguez and Defendant David  
2 Rodriguez, are the true registrants and co-owners of the Disputed Domain Name.<sup>1</sup>

3 12. Defendant David Rodriguez is an individual who can be reached at 727  
4 Industrial Parkway West, Suite P, Hayward, California 94544. Mr. Rodriguez is the owner and  
5 operator of the automobile transmission repair business offered under the business name AAA  
6 Transmission. Moreover, on information and belief, Mr. Rodriguez and Ms. Rodriguez are the  
7 true registrants and co-owners of the Disputed Domain Name.

8 **FACTS ENTITLING PLAINTIFF TO RELIEF**

9 **A. AAA's Widespread and Substantial Trademark Use**

10 13. Since its founding over a century ago, AAA has enjoyed a reputation as  
11 one of the world's premier client service organizations. That reputation is largely based upon  
12 the quality and reliability of the many products and services it offers through its AAA local  
13 clubs.

14 14. Although its original focus was on combating unfair automobile laws and  
15 campaigning for better roads and more reliable vehicles, AAA quickly expanded its charter. It  
16 established itself almost immediately as an advocate for travel safety and road improvement.  
17 Shortly thereafter, it also became associated with reliable travel-related information. Today  
18 AAA offers a broad range of products and services, including, but also going beyond,  
19 automobiles and travel.

20 15. AAA has invested significant resources to develop and foster the  
21 reputation, recognition, and goodwill associated with its products and services. AAA's efforts  
22 include extensive advertising campaigns and promotional efforts along with retaining that  
23 goodwill by maintaining AAA's commitment to quality and reliability.

24  
25  
26 <sup>1</sup> The Registrant listed in the WHOIS records for the Disputed Domain Name is a proxy  
27 identified as admin33809 and associated with the email address IYPNotifications@att.com.  
28 AAA sent all written communications to this email address and received responses from Mr.  
and Ms. Rodriguez, owners of the business advertised on the website associated with the  
Disputed Domain Name.

1           16.     AAA has used the AAA Marks and logo designs in interstate commerce  
2 to identify a wide range of products and services for decades. Only those businesses that are  
3 part of AAA's network of approved service providers are authorized to use or display the AAA  
4 Marks. Consequently, AAA members and the public know that local businesses displaying one  
5 of AAA's Marks are selected only if they maintain excellent reputations for quality, integrity,  
6 reliability, and service.

7           17.     AAA and its local clubs have registered many AAA-related domain  
8 names and maintain several Internet websites through which AAA members and members of the  
9 general public may obtain information and, in some cases, purchase or use the products and  
10 services (the "AAA Websites").

11           18.     The AAA Websites are created and operated, in part, for purposes of  
12 attracting potential members and customers, encouraging their interest in AAA and its local  
13 clubs, and offering products and services to customers in the United States.

14           19.     AAA has been selective in permitting businesses and organizations to use  
15 the AAA Marks in connection with their products and services, including on the Internet.  
16 Businesses and organizations that AAA has permitted to use the AAA Marks (including the  
17 AAA local clubs) are selected and permitted to do so if, and only if, they maintain excellent  
18 reputations for quality, integrity, reliability, and service.

19           20.     As a result of AAA's history and experience providing high quality  
20 products and services through the AAA local clubs, and as a result of the continuous and  
21 extensive advertising, promotion, and sales of products and services under the AAA Marks,  
22 those trademarks have acquired substantial value and fame in the United States and throughout  
23 the World.

24           21.     Further, the AAA Marks are widely recognized by consumers in this  
25 country and abroad and have acquired enormous goodwill as trademarks identifying high  
26 quality and reliable products and services. Indeed, the AAA Marks are distinctive such that  
27 consumers recognize that goods and services marketed under the AAA Marks originate with, or  
28 are approved or endorsed by, AAA and the AAA local clubs.

1           22.    AAA has registered with the United States Patent and Trademark Office  
2 more than 70 of its AAA Marks, which AAA has used since at least 1902 in connection with the  
3 broad array of products and services offered to its members. The federal registrations  
4 Defendants are violating are:

5                   A.    Reg. No. 829,265 for the AAA Mark, used in connection with  
6 automobile association services rendered to motor vehicle owners, motorists, and  
7 travelers;

8                   B.    Reg. No. 2,158,654, for the AAA Mark & Design used in  
9 connection with a variety of automobile related goods and services, among others; and

10                  C.    Reg. No. 3,316,227, for the AAA Mark & Design, used in  
11 connection with indicating membership in an automobile club.

12 Copies of the registration certificates for the above marks are available via the United States  
13 Patent and Trademark Office website: <<http://www.uspto.gov>>.

14           23.    Pursuant to 15 U.S.C. § 1057(b), the registration certificates for the AAA  
15 trademarks, including the marks identified in paragraph 22, constitute *prima facie* evidence of  
16 the validity of those registrations, of AAA's ownership of the trademarks set forth therein, and  
17 of AAA's exclusive right to use those trademarks in commerce and in connection with the  
18 products and services specified in the registration certificates.

19           B.    Defendants' Unlawful Use of Plaintiff's AAA Marks

20                   24.    AAA has never authorized Defendants to use the AAA Marks.

21                   25.    Notwithstanding, as set forth below, Defendants have knowingly and  
22 willfully violated AAA's rights in the famous and distinctive AAA Marks by using in  
23 commerce the AAA Marks and have damaged, or are likely to damage, the reputation,  
24 recognition, and goodwill associated with the famous and distinctive AAA Marks.

25                   1.    *Defendants' Unlawful Use*

26                   26.    Defendants use the AAA Marks to designate and advertise their  
27 automobile transmission repair business. Specifically, Defendants operate an automobile  
28 transmission repair service under the business name AAA Transmission. Moreover, Defendants

1 have registered the Disputed Domain Name and use it to host a website advertising their  
2 transmission repair services under the same name.

3 27. Defendants' unauthorized use has been and continues to be of  
4 commercial value to Defendants.

5 2. *Defendants' Failure to Comply with AAA's Notices*

6 28. In or around November 2010, AAA learned that Defendants were  
7 operating an automobile transmission business under the name AAA Transmission and had  
8 registered the Disputed Domain Name to host a website advertising their transmission repair  
9 services.

10 29. On November 30, AAA sent a letter by email and certified mail to  
11 Defendants, informing them that the unauthorized use of the AAA Marks in their business  
12 name, on their website, and in the Disputed Domain Name violates the Lanham Act as well as  
13 state statutes and common law, and demanding that Defendants cease all use of the AAA Marks  
14 in their business name.

15 30. On December 3, counsel for AAA received a phone call from Ms.  
16 Rodriguez, who admitted that she owns AAA Transmission. AAA's counsel provided  
17 additional information regarding AAA's trademark rights and the likelihood of confusion  
18 caused by her business name and website. At the conclusion of the call, Ms. Rodriguez stated  
19 that she may wish to consult an attorney, and AAA's counsel asked to be informed if she did so.

20 31. In the ensuing weeks, Defendants' unauthorized use continued, and AAA  
21 did not receive any communication from counsel representing Defendants. As a result, on  
22 January 6, 2011, AAA left a voicemail message for Ms. Rodriguez, requesting that she have her  
23 attorney contact AAA if she had retained counsel, and, if not, that she respond herself regarding  
24 Defendants' willingness to comply with AAA's request that Defendants cease unauthorized use  
25 of the AAA Marks.

26 32. AAA received no response and therefore sent a second cease and desist  
27 letter to Defendants on January 28.

28



1           33. On March 11, AAA received a letter from David Rodriguez, co-owner of  
2 AAA Transmission. In that letter, Mr. Rodriguez rejected AAA's request that Defendants cease  
3 their unauthorized use of the AAA Marks and stated that Defendants' unauthorized use would  
4 continue.

5           34. Defendants, despite receiving actual notice that their continued  
6 unauthorized use of the AAA Marks constitutes actionable trademark infringement, false  
7 designation of origin, trademark dilution, cyberpiracy, and unfair competition, continue to use  
8 the AAA Marks and continue to benefit from their unauthorized use.

9           35. Defendants' continued unauthorized use of the AAA Marks conveys to  
10 consumers and members of the general public the false impression that Defendants and the  
11 products and services they offer are sponsored, approved, or endorsed by AAA.

12           36. On information and belief, Defendants' use of the AAA Marks is of  
13 commercial value to them because consumers seeking to purchase automobile transmission  
14 repair services have, and will continue to contact Defendants, after viewing Defendants'  
15 website, erroneously believing that they are approved or endorsed by AAA.

16           37. Plaintiff's AAA Marks are famous and distinctive, became famous and  
17 distinctive before Defendants began their unauthorized use, and are entitled to a broad scope of  
18 protection. Defendants' unauthorized use lessens the capacity of Plaintiff's AAA Marks to  
19 identify and distinguish the products and services provided or endorsed by, or affiliated with,  
20 AAA under the AAA Marks, and thus dilutes the distinctive quality of the Marks.

21           38. On information and belief, Defendants' unlawful conduct as set forth  
22 herein has been and continues to be willful, deliberate, and in bad faith.

23           39. For the foregoing reasons, Defendants' unlawful conduct has caused and  
24 likely will continue to cause injury to AAA and to the goodwill and value of its AAA Marks.  
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27  
28

**FIRST CLAIM FOR RELIEF:**

**FEDERAL TRADEMARK INFRINGEMENT**

**(LANHAM ACT § 32, 15 U.S.C. § 1114)**

40. AAA repeats and realleges the allegations set forth in paragraphs 1-39 above.

41. Defendants' unauthorized use of the AAA Marks violates Section 32 of the Lanham Act, 15 U.S.C. § 1114, because such conduct constitutes willful and deliberate use in commerce of reproductions, copies and/or colorable imitations of AAA's federally registered AAA Marks in connection with the sale, offering for sale, distribution, and advertising of Defendants' products and services in a manner likely to cause confusion, mistake, and deception.

42. Defendants' unlawful conduct as set forth herein has been and continues to be willful, deliberate, and in bad faith.

43. Defendants' unlawful conduct has irreparably damaged AAA, and it has no adequate remedy at law. Unless enjoined, Defendants will continue the unlawful conduct, further injuring AAA and confusing the public.

44. On information and belief, Defendants have received substantial revenues and substantial profits as a result of their unlawful conduct, to which Defendants are not entitled, and AAA has also suffered damages as a result of such unlawful conduct for which Defendants are responsible.

**SECOND CLAIM FOR RELIEF:**

**FALSE DESIGNATION OF ORIGIN AND UNFAIR COMPETITION**

**(LANHAM ACT § 43(a), 15 U.S.C. § 1125(a))**

45. AAA repeats and realleges the allegations set forth in paragraphs 1-44 above.

46. Defendants' unauthorized use of the AAA Marks violates Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). Defendants willfully and deliberately use in commerce words, terms, names, and/or false designations of origin that likely caused confusion,

1 mistake, and deception as to the origin, sponsorship, or approval by AAA of services promoted  
2 by Defendants. This conduct constitutes unfair competition and infringement of Plaintiff's  
3 AAA Marks.

4 47. Defendants' unlawful conduct as set forth herein has been and continues  
5 to be willful, deliberate, and in bad faith.

6 48. Defendants' unlawful conduct has irreparably damaged AAA, and it has  
7 no adequate remedy at law. Unless enjoined, Defendants will continue the unlawful conduct,  
8 further injuring AAA and confusing the public.

9 49. On information and belief, Defendants have received substantial revenues  
10 and substantial profits as a result of their unlawful conduct, to which Defendants are not  
11 entitled, and AAA has also suffered damages as a result of such unlawful conduct for which  
12 Defendants are responsible.

13 **THIRD CLAIM FOR RELIEF:**

14 **FEDERAL TRADEMARK DILUTION**

15 **(LANHAM ACT § 43(c), 15 U.S.C. § 1125(c))**

16 50. AAA repeats and realleges the allegations set forth in paragraphs 1-49  
17 above.

18 51. Defendants' unauthorized use of the AAA Marks violates Section 43(c)  
19 of the Lanham Act, 15 U.S.C. § 1125(c). Defendants' use, which commenced after Plaintiff's  
20 AAA Marks became famous, is intended to derive a commercial benefit from the value and  
21 goodwill associated with the AAA Marks and has caused dilution of the distinctive quality of  
22 the Marks. In addition, Defendants' use of the AAA Marks is likely to cause dilution by  
23 tarnishment by harming the reputation of the famous AAA Marks.

24 52. Defendants' unlawful conduct as set forth herein has been and continues  
25 to be willful, deliberate, and in bad faith.

26 53. Defendants' unlawful conduct has irreparably damaged AAA, and it has  
27 no adequate remedy at law. Unless enjoined, Defendants will continue the unlawful conduct,  
28 further injuring AAA and confusing the public.

**FOURTH CLAIM FOR RELIEF:**  
**CALIFORNIA TRADEMARK DILUTION**  
**(CAL. BUS. & PROF. CODE § 14247)**

54. AAA repeats and realleges the allegations set forth in paragraphs 1-53 above.

55. Defendants' unauthorized use of the AAA Marks, which commenced after Plaintiff's AAA Marks became famous, violate California Business & Professions Code Section 14247. Defendants' unauthorized use creates a likelihood of association with Plaintiff's famous AAA Marks because the use is identical, or nearly identical, to Plaintiff's famous marks. Defendants' acts are likely to cause dilution by blurring by impairing the distinctive quality of Plaintiff's famous AAA Marks. In addition, Defendants' use of the AAA Marks is likely to cause dilution by tarnishment by harming the reputation of the famous AAA Marks. Specifically, Defendants' continued use of the AAA Marks to designate and advertise their business that is not authorized by AAA may harm consumers' opinions of, and reliance on, AAA's Marks, if the goods and services do not satisfy AAA's exacting criteria for quality and reliability.

56. Defendants' unlawful conduct as set forth herein has been and continues to be willful, deliberate, and in bad faith.

57. Defendants' violation of the statute has caused and will continue to cause irreparable damage to AAA, for which AAA has no adequate remedy at law. Unless enjoined, Defendants will continue to use the AAA Marks, further injuring AAA and confusing the public.

**FIFTH CLAIM FOR RELIEF:**  
**UNFAIR COMPETITION BY INFRINGEMENT OF COMMON LAW RIGHTS**

58. AAA repeats and realleges the allegations set forth in paragraphs 1-57 above.

59. Defendants' unauthorized use of the AAA Marks constitutes unfair competition and an infringement of AAA's common law rights in the AAA Marks because

1 AAA is the prior user of the AAA Marks, and Defendants' willful and deliberate use of the  
2 AAA Marks in commerce is likely to cause, and may have already caused, confusion, mistake,  
3 and deception as to the origin, sponsorship, or approval by AAA of the products and services  
4 provided by Defendants.

5 60. Defendants' unlawful conduct as set forth herein has been and continues  
6 to be willful, deliberate, and in bad faith.

7 61. Defendants' unlawful conduct has and will continue to cause irreparable  
8 damage to AAA, for which AAA has no adequate remedy at law. Unless enjoined, Defendants  
9 will continue to use the AAA Marks, further injuring AAA and confusing the public.

10 62. On information and belief, Defendants have received substantial revenues  
11 and substantial profits as a result of their unlawful conduct, to which Defendants are not  
12 entitled, and AAA has also suffered damages as a result of such unlawful conduct for which  
13 Defendants are responsible.

14 **SIXTH CLAIM FOR RELIEF:**

15 **COMMON LAW TRADEMARK DILUTION**

16 63. AAA repeats and realleges the allegations set forth in paragraphs 1-62  
17 above.

18 64. Defendants' unauthorized use of the AAA Marks, which commenced  
19 after Plaintiff's AAA Marks became famous, violates the common law of California in that  
20 Defendants' uses of the AAA Marks create a likelihood of association with Plaintiff's famous  
21 AAA Marks because they are identical to, or nearly identical to, Plaintiff's famous marks.  
22 Defendants' acts are likely to cause dilution by blurring by impairing the distinctive quality of  
23 Plaintiff's famous AAA Marks. Moreover, Defendants' use of the AAA Marks in commerce is  
24 likely to cause dilution by tarnishment. Specifically, Defendants' continued use of the AAA  
25 Marks to designate and advertise their business that is not authorized by AAA may harm  
26 consumers' opinions of, and reliance on, AAA's Marks if the goods and services do not satisfy  
27 AAA's exacting criteria for quality and reliability.  
28

1           65. Defendants' unlawful conduct as set forth herein has been and continues  
2 to be willful, deliberate, and in bad faith.

3           66. Defendants' violation of the common law of California has caused and  
4 will continue to cause irreparable damage to AAA, for which AAA has no adequate remedy at  
5 law. Unless enjoined, Defendants will continue to use the AAA Marks, further injuring AAA  
6 and confusing the public.

7                           **SEVENTH CLAIM FOR RELIEF:**

8                           **FEDERAL TRADEMARK CYBERPIRACY**

9                           **(LANHAM ACT § 43(d), 15 U.S.C. § 1125(d))**

10           67. AAA repeats and realleges that allegations set forth in paragraphs 1-66  
11 above.

12           68. Defendants' unauthorized registration and use of the Disputed Domain  
13 Name violates AAA's rights under Section 43(d) of the Lanham Act, 15 U.S.C. § 1125(d),  
14 because: (i) Plaintiff is the owner of the AAA Marks, which are registered in the United States  
15 Patent and Trademark Office and protected under the Lanham Act, 15 U.S.C. §§ 43(a), (c), and  
16 (d); (ii) Defendants registered, trafficked in, and/or used the Disputed Domain Name with a bad  
17 faith intent to profit from AAA's already famous and distinctive AAA Marks; (iii) the Disputed  
18 Domain Name is confusingly similar to Plaintiff's AAA Marks; and (iv) Plaintiff's AAA Marks  
19 were distinctive and famous at the time of the registration of the Disputed Domain Name.

20           69. Defendants' unlawful conduct as set forth herein has been and continues  
21 to be willful, deliberate, and in bad faith.

22           70. Defendants' violation of the statute has caused and will continue to cause  
23 irreparable damage to AAA, for which AAA has no adequate remedy at law. Unless enjoined,  
24 Defendants will continue to use the AAA Marks and Disputed Domain Name, further injuring  
25 AAA and confusing the public.

26           71. On information and belief, Defendants have received substantial revenues  
27 and substantial profits as a result of their unlawful conduct, to which Defendants are not  
28

1 entitled, and AAA has also suffered damages as a result of such unlawful conduct, for which  
2 Defendants are responsible.

3 **EIGHTH CLAIM FOR RELIEF:**

4 **CALIFORNIA UNFAIR COMPETITION LAW**

5 **(CAL. BUS. & PROF. CODE § 17200)**

6 72. AAA repeats and realleges the allegations set forth in paragraphs 1-71  
7 above.

8 73. Defendants' unauthorized use violates the California Unfair Competition  
9 Law, Cal. Bus. & Prof. Code § 17200, *et seq.*, because it constitutes unfair, unlawful, and  
10 fraudulent conduct.

11 74. Defendants' conduct is unfair in violation of Section 17200 because it  
12 allows Defendants to benefit unjustly by virtue of the goodwill and positive reputation that  
13 members of the general public associate with AAA and AAA's goods and services. As  
14 described herein, and on information and belief, Defendants have violated, and continue to  
15 violate, AAA's rights in the AAA Marks in order to enjoy the commercial benefits derived there  
16 from.

17 75. Defendants' conduct is unlawful in violation of Section 17200 because it  
18 violates, among others, Sections 32, 43(a), and 43(c) of the Federal Trademark Act ("Lanham  
19 Act"), 15 U.S.C. § 1114, 1125(a) and (c), California Business & Professions Code Section  
20 14247, and California common law as described above.

21 76. Defendants' conduct is fraudulent in violation of Section 17200 because  
22 this conduct is likely to deceive, and may have already deceived, the general public as to  
23 whether the services offered by AAA Transmission are approved or endorsed by, or are  
24 otherwise affiliated with, AAA. As a direct and proximate result of Defendants' unauthorized  
25 use of the AAA Marks, members of the general public may have mistakenly believed, and will  
26 likely continue to believe, that Defendants' services are approved or endorsed by, or otherwise  
27 affiliated with, AAA.

1           77. Defendants' unlawful conduct as set forth herein has been and continues  
2 to be willful, deliberate, and in bad faith.

3           78. Defendants' violation of the statute has caused and will continue to cause  
4 irreparable damage to AAA and the public, for which AAA has no adequate remedy at law.  
5 Unless enjoined, Defendants will continue to use the AAA Marks, further injuring AAA and  
6 confusing the public.

7           79. On information and belief, Defendants have received substantial revenues  
8 and substantial profits as a result of their unlawful conduct, to which Defendants are not  
9 entitled, and AAA has also suffered damages as a result of such unlawful conduct for which  
10 Defendants are responsible.

11           80. As a direct, proximate, and foreseeable result of the Defendants'  
12 wrongful conduct, as alleged above, AAA has been injured and has lost, and continues to lose,  
13 income it otherwise would have received from its customers. AAA is entitled to relief,  
14 including full restitution and/or disgorgement of all revenues, earnings, profits, compensation,  
15 and benefits that may have been obtained by Defendants as a result of such unfair business acts  
16 or practices.

17                           **PRAYER FOR RELIEF**

18           Wherefore, AAA respectfully seeks the following relief:

19           1. Enjoin and restrain Defendants, their agents, servants, employees,  
20 attorneys, and any and all persons in active concert or participation with any of them, from  
21 engaging in any of the following acts:

22                   (a) Using without the authorization of AAA any of AAA's Marks,  
23 logos, and trade names, including, but not limited to, the AAA Mark & Design,  
24 the designation "AAA," or any other name, logo, or mark that includes the  
25 designation "AAA" or that is confusingly or deceptively similar to any of AAA's  
26 Marks, logos, and trade names, either alone or in conjunction with other words or  
27 symbols, as part of any trademark, service mark, logo, trade name, corporate  
28 name, assumed name, domain name, sub-domain name, website, or email



1 address, on or in relation to any goods or services sold or distributed by  
2 Defendants, or in any other manner; and

3 (b) Using the letter "A" or any multiple combination of letters "A" in  
4 any form or manner that would tend to identify or associate Defendants or their  
5 business or services with AAA, including, without limitation, in the marketing,  
6 promotion, advertising, identification, sale or distribution of goods or services, or  
7 in any other manner;

8 2. Require Defendants, pursuant to 15 U.S.C. § 1118, to destroy all  
9 literature, signs, labels, prints, packages, wrappers, containers, advertising materials, Internet  
10 content, stationary, software, and any other items in their possession or control which contain  
11 the infringing designations "AAA" or any term, symbol, or logo confusingly similar to "AAA,"  
12 either alone or in combination with other words or symbols and to destroy all plates, molds,  
13 matrices, masters, and other means in their possession or control with which they can make any  
14 of those infringing items;

15 3. Require Defendants to transfer or cancel their registration for the  
16 Disputed Domain Name and any other domain names in their control that contain "AAA";

17 4. Require Defendants to file with the Court and serve on AAA, within  
18 thirty (30) days after entry of an injunction, a report in writing, under oath, setting forth in detail  
19 the manner in which Defendants have complied with the injunction;

20 5. Require Defendants to pay to AAA an amount yet to be determined to  
21 compensate AAA for all damages sustained as a result of Defendants' unlawful conduct  
22 described above, plus interest thereon, and require with respect to damages resulting from  
23 infringement or dilution of the AAA Marks or from unfair competition under the Lanham Act  
24 that such damages be trebled pursuant to 15 U.S.C. § 1117;

25 6. Require Defendants to account for and pay to AAA all the profits derived  
26 by Defendants resulting from their use of the AAA Marks;

1                   7.     Requiring Defendants to make restitution and/or disgorge to AAA of all  
2 revenues, earnings, profits, compensation, and benefits that may have been obtained by  
3 Defendants as a result of their unfair business acts or practices;

4                   8.     Award AAA punitive damages;

5                   9.     Award AAA the costs of this suit and its reasonable attorneys' fees in  
6 accordance with 15 U.S.C. § 1117 and California law;

7                   10.    Award AAA statutory damages in the amount of \$100,000 per Disputed  
8 Domain Name pursuant to 15 U.S.C. § 1117(d), or some other amount as the Court considers  
9 just;

10                  11.    Award prejudgment interest on all liquidated sums; and

11                  12.    Award such other and further relief as the Court deems just and proper.  
12

13     March 22, 2011

COVINGTON & BURLING LLP

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16     By: 

17     Leslie N. Harvey

18     Attorneys for Plaintiff THE AMERICAN  
19     AUTOMOBILE ASSOCIATION, INC.  
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